

REMARKS

Status of Claims / Summary of the Amendment

Claims 54-56 and 63-70 are currently pending. The rejections of the claims and reasons why Applicant believes that all of the pending claims are currently in condition for allowance are discussed below.

Rejections Under 35 U.S.C. § 112

Rejections Under 35 U.S.C. § 112, first paragraph

Claims 54-56 and 63-70 were rejected under 35 U.S.C. § 112, first paragraph. The Office Action rejected independent Claims 54 and 63 as being non-enabling due to claim language added in the previous amendment. This claim language has been removed. Therefore, Applicant respectfully submits that the rejections under 35 U.S.C. § 112, first paragraph have been overcome.

Dependent claims 55-56 and 64-70 were rejected as depending from a rejected base claim, i.e., either Claim 54 or Claim 63. Since independent Claims 54 and 63 are believed allowable, dependent Claims 55-56 and 64-70 are also believed allowable.

Rejections Under 35 U.S.C. § 112, second paragraph

Claims 54-56 and 63-70 were rejected under 35 U.S.C. § 112, second paragraph. The Office Action rejected independent Claims 54 and 63 as lacking antecedent basis for “the arranged dots” and “the predetermined positions.” The claims have been amended to modify the claim language indicated as being unclear. Therefore, Applicant respectfully submits that the rejections under 35 U.S.C. § 112, first paragraph have been overcome.

Rejections Under 35 U.S.C. § 103

Claims 54-56 and 63-70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsunoshita (U.S. Patent Publication No. 2003-0179412) in view of Shimada et al. (U.S. Patent Publication No. 2004-0021311).

A Prima Facie Case of Obviousness Has Not Been Established

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

There is No Motivation to Combine The References

The Office Action states that “it would have been obvious to one of ordinary skill at in the art at the time the invention was made to have incorporated Shimada’s teaching into Matsunoshita because the printed matter of Matsunoshita can be irradiated with UV rays of Shimada so that the latent image can be visually recognized/extracted.”

Applicant respectfully disagrees that there is such a motivation to combine the references. The Shimada et al. reference is directed to printed matter in which a latent image cannot be visibly identified under ordinary visible light but appears upon being irradiated with UV rays. The Matsunoshita reference does not deal with printed matter in which a latent image cannot be visibly identified under ordinary visible light. On the contrary, the Matsunoshita reference deals with latent images that can be seen by the human, for example, see Fig. 6B. Not only is there no motivation to combine the references, but the references themselves teach away from such a combination.

The References Do Not Teach All of The Claim Limitations

As discussed above, there is no motivation to combine the references. *Assuming arguendo* that there was motivation to combine the references, such a combination does not teach or suggest all of the claim limitations.

With reference to independent Claims 54 and 63, the Office Action notes that the Matsunoshita reference is silent as to the claim limitation “wherein the additional information can be extracted based on the difference between the positions of the arranged dots and predetermined positions.”

The Office Action alleges that the Shimada et al. reference cures this defect. Applicant respectfully disagrees. The Shimada et al. reference does not teach or suggest “wherein the additional information can be extracted based on the difference between the positions of the arranged dots and predetermined positions.” Applicant can not find such a teaching anywhere in the reference. The Office Action alleges that such a disclosure can be found in Paragraphs [0101], [0110] and [0166]. Applicant respectfully disagrees. The Shimada et al. reference discloses that the latent image that is unnoticeable under ordinary light becomes visible under UV light. Paragraph [0101]. The Shimada et al. reference further discloses that in embodiments of the Shimada et al. reference, the latent image lines need to fall within 90% to 110% of the image line with of the non-latent image line. Paragraph [110]. The Shimada et al. reference further discloses that in embodiments the printed matter is irradiated with UV rays having a wavelength of 365 nm using a UV irradiator. Paragraph [0166].

Furthermore, Claims 54 and 63 have been amended and the limitation discussed above now reads “wherein it can be determined whether an image on a printed material is an original because the additional information can be extracted from the original image based on the positions of the arranged second dots and predetermined positions in the latent-image area, and the additional information cannot be extracted from a copy.” Neither of the cited and applied references teach or suggest this limitation.

The cited and applied references, when taken alone or in combination, do not teach or suggest all of the limitations of independent Claims 54 and 63.

Because independent Claims 54 and 63 are allowable, all of the claims depending therefrom, namely, Claims 55-56 and 64-70 are believed allowable. Furthermore, each of the dependent claims contains additional allowable subject matter.

For example, the Office Action acknowledges that the Matsunoshita reference is silent as to the claim limitation “wherein the additional information can be extracted based on the difference between the positions of the arranged dots and predetermined positions.” However, with reference to Claims 55 and 64, the Office Action then goes on to allege that the Matsunoshita discloses the “wherein the additional information can be extracted based on the difference between the positions of the arranged dots and predetermined positions in the vertical axis and the difference between the positions of

the arranged dots and the predetermined positions in the horizontal axis.” As the Office Action stated earlier, the Matsunoshita is silent as to this limitation.

The Office Action similarly suggests that while the Matsunoshita reference is silent as to the claim limitation “wherein the additional information can be extracted based on the difference between the positions of the arranged dots and predetermined positions,” that the Matsunoshita and Shimada et al. reference disclose “wherein the additional information can be extracted based on whether the result of multiplication of the difference between the positions of the arranged dots and predetermined positions in the vertical axis and the difference between the positions of the arranged dots and the predetermined positions in the horizontal axis is negative or positive.” The description provided only discusses the Matsunoshita reference which, as already noted in the Office Action, does not disclose this limitation.

CONCLUSION

A prima facie case of obviousness has not been established. Applicant respectfully submits that all of the claims pending in the application meet the requirements for patentability and respectfully requests that the Examiner indicate the allowance of such claims.

Any amendments to the claims which have been made in this response which have not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If any additional fee is required, please charge Deposit Account Number 502456.

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Should the Examiner have any questions, the Examiner may contact Applicant's representative at the telephone number below.

Respectfully submitted,

February 27, 2007

/Marlene Klein/

Date

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